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PATENT

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In The United States Patent And Trademark Office

Appl. No.: 09/876,760

Confirmation No.: 2221

Applicant(s): Scheuber et al.

Filed: June 7, 2001

Art Unit: 2854

Examiner: J. E. Culler

Title: METHOD AND APPARATUS FOR PROVIDING TEXT ON PRINTED PRODUCTS

Docket No.: 034183/233887

Customer No.: 00826

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF TRANSMITTAL

(PATENT APPLICATION - 37 C.F.R. § 41.37)

1. Transmitted herewith is the APPEAL BRIEF under 37 CFR §41.37, which is in response to the Notice of Appeal filed on July 19, 2004 and the Order Returning Undocketed Appeal to Examiner mailed May 31, 2005 by the Board of Appeals and Interferences.
2. Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief in the amount of \$330.00 was submitted with the Appeal Brief filed September 20, 2004. Any additional fee or refund may be charged to Deposit Account 16-0605.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Scheuber et al. Confirmation No.: 2221  
Appl. No.: 09/876,760 Group Art Unit: 2854  
Filed: June 7, 2001 Examiner: J. E. Culler  
For: METHOD AND APPARATUS FOR PROVIDING TEXT ON PRINTED  
PRODUCTS

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 CFR § 41.37

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed July 19, 2004, and the Order Returning Undocketed Appeal to Examiner mailed May 31, 2005.

(i) ***Real Party in Interest.***

The real party in interest in this appeal is Ferag AG, located in Hinwil, Switzerland, the assignee of the above-referenced patent application, as evidenced by the Assignment recorded at Reel 9180, Frame 0650 on May 14, 1998 in parent application 09/078,914 (now Patent No. 6,695,028).

(ii) ***Related Appeals and Interferences.***

Appeal No. 2002-2125 was filed in the parent application 09/078,914 on August 22, 2001, and a Decision was rendered on May 23, 2003. The parent application issued as Patent No. 6,695,028 on February 24, 2004. A copy of the Decision rendered May 23, 2003 is included in the Related Proceedings Appendix attached to this Appeal Brief below.

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(iii) ***Status of Claims.***

The claims under appeal are Claims 5-14 which are reproduced in the Claims Appendix which is attached to this Brief. Claims 1-4 are cancelled.

(iv) ***Status of Amendments.***

No amendments have been filed since the final Office Action dated April 16, 2004, and there are no exhibits.

(v) ***Summary of the Claimed Subject Matter.***

The invention of base Claim 5 is directed to a method for applying printed information 18', such as an address label, in an exposed border region 38 of each of a plurality of printed products 10 moving in an imbricated, i.e. partially overlapping, stream S of the products, note Fig. 7.

In the embodiment recited in the claims of present application, the text is applied by printing a partially transparent contrast panel 14 onto the exposed border region of each printed product, using for example a partially transparent white ink, note page 6, lines 20-23 of the specification of the present application. The text 18 is then formed within or on each contrast panel, such as by printing the contrast panel or forming blank areas within the contrast panel.

The invention achieves the highly desirable and novel result of assuring that any underlying printed text which may be present in the exposed border region, as well as the information formed on the contrast panel, can be seen and read.

The phrase "partially transparent contrast panel" is defined in the specification and claims as forming a good contrast with the information formed thereon and also allowing

the underlying printed information to be seen and read, note particularly the paragraph beginning at page 3, line 32, and the paragraph beginning at page 6, line 16 of the specification. Also, the left side of Figure 2 illustrates a partially transparent contrast panel at **14**, and as indicated the underlying printed information **10'** can be seen therethrough. Viewing the right side of Figure 2, the printed text **18** on the contrast panel is clearly visible.

Independent method Claim 8 defines the invention substantially as described above, but further specifically recites that the step of printing the partially transparent contrast panel onto the exposed border region of each printed product, involves printing the contrast panel so as to overlie the printing on the printed surface of the product and so as to allow the printing on the printed surface to be seen therethrough. The resulting product is shown in the right side of Fig. 2.

Independent apparatus Claim 11 defines the invention to include a conveyor system **24** for conveying the printed products **10** in an overlapping imbricated stream, and as seen in Fig. 7, a label printing means for printing the partially transparent contrast panel **14** as defined above onto the exposed border region of each product **10**, and for forming the information **18'** within or on the contrast panel **14**. Thus the printing means serves to print the contrast panel and the information in superposed relationship. As recited in dependent Claim 12, this printing means comprises first and second spaced apart printers **28** and **30**.

It is not believed that method Claims 5-10 include any means plus function, or step plus function, recitations as permitted by 35 USC 112§6.

Apparatus Claim 11 is seen to have the following means plus function recitation: "printing means...for printing...and for forming". This printing means is described in the specification at page 8, line 31 to page 9, line 9, as comprising a first printing station 28 and a second printing station 30 which are spaced apart from one another as seen in the conveying direction F, note Fig. 7.

It is submitted that the "conveyor means" as recited in apparatus Claim 11 does not fall within the purview of 112§6, since the word "conveyor" imparts sufficient structure for achieving the specified function, note Section 2181I of the MPEP.

(vi) ***Grounds Of Rejection To Be Reviewed On Appeal.***

(a) Claims 5, 7-8, 10-11 and 13 were rejected as being unpatentable under §103 of the Patent Statute over Mowry Patent No. 4,681,348 in view of Fröhlich Patent No. 4,983,990.

(b) Claims 6, 9, and 12 were rejected as being unpatentable under §103 of the Patent Statute over Mowry in view of Fröhlich and further in view of Gurwich Patent No. 2,084,026.

(c) Claim 14 was rejected as being unpatentable under §103 of the Patent Statute over Mowry in view of Fröhlich and further in view of Reist Patent No. 4,538,161.

(d) Claims 5-13 were rejected as being unpatentable under §103 of the Patent Statute over "A Century of Comics" in view of Fröhlich.

(e) Claim 14 was rejected as being unpatentable under §103 of the Patent Statute over "A Century of Comics" in view of Fröhlich and further in view of Reist.

8. **Argument.**

(a) Claims 5, 7-8, 10-11 and 13 stand rejected as being unpatentable over Mowry in view of Fröhlich.

The subject matter of the cited prior patent to Mowry relates to a financial document, i.e. a check or a money order, which is protected against alteration. The document includes an amount receiving area 20 and an area 26 for carrying a message. The areas 20 and 26 are coated with layers 50 and 52 respectively of self-contained pressure sensitive image forming chemicals. The chemicals are released from frangible capsules (column 1, lines 59-65) upon application of pressure exerted by a printer, then react and form the printed numerals and characters in the areas 20 and 26.

It is submitted that the subject matter of the Mowry patent as summarized above is outside the field of technology to which the present invention relates and it is unrelated to the problem solved by the present invention. As such, the Mowry patent must be considered non-analogous art and it should not be employed in the obviousness determination as defined by 35 USC §103, see *In re Wood*, 202 USPQ 171 (CCPA 1979).

More particularly, the field of technology of the present invention relates to methods and apparatus for providing individualized text, e.g. address labels, on newspapers, periodicals and similar printed products which are being processed at high speeds in an imbricated stream. Mowry on the other hand relates to the field of financial documents which are designed to protect against alteration. One skilled in the former field of technology would not have looked to the latter field of technology in dealing with the problem associated with applying address labels to printed products

which are being processed in an imbricated stream at high speeds.

In the final Official Action, the Examiner attempted to respond to the above contention by broadly defining the field of technology as "printing" and defining the problem as "printing information in more than one layer", note paragraph 7 of the Official Action of April 16, 2004. It is submitted that these definitions do not fairly state the applicable standard under which obviousness should be determined under 35 USC §103, in that the field of technology should not be defined so broadly as to extend clearly beyond the capabilities of "a person having ordinary skill in the art to which said subject matter pertains". Also, the Examiner's stated common problem of "printing information in more than one layer" is not a problem of either the present invention or of Mowry.

In the Examiner's Answer mailed November 16, 2004, the Examiner contended that a broad definition of the field of technology as that of printing is appropriate because

"there is no language in the claims which narrows the definition beyond the application of printed text and information to a plurality of printed products. For example, appellant argues that one skilled in the former field of technology would not look to the latter field of technology to deal with the problems associated with applying labels to printed products which are being processed in an imbricated stream of high speeds. However, applicant's claims do not include these features."

The Examiner's contention is incorrect. Base Claim 5 specifically recites the step of conveying the printed products along a path of travel in an overlapping imbricated stream. The other base Claims 8 and 11 contain similar recitations. Thus the claims clearly limit the invention to a

field which is much more narrow than the broad concept of printing a plurality of products.

In support of her position, the Examiner has referred to the case *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992) in the Examiner's Answer. This case is seen to clearly support the applicant's position regarding the impropriety of combining the disclosures of Mowry and Fröhlich. Specifically, in Oetiker decision, the CAFC reversed the Board's rejection based upon a combination of references, and the Court stated:

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

In the present case, it defies "common sense" to allege that one working in the field of printing address labels on products being conveyed in an imbricated stream would look to the individual printing of financial documents as disclosed by Mowry, for guidance on improvements.

The above analysis also compels the conclusion that the proposed combination of Mowry and Fröhlich is legally untenable under §103, and the rejections based thereupon should be overruled. Also, it is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.



*ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Fröhlich patent discloses a process and apparatus for conveying printed products 20 in an imbricated stream, and wherein the printed products are laterally displaced so as to expose the side margins of the products. An ink jet writer 34' is provided for applying an address to each product on the exposed side margin. More particularly, the ink jet writer 34' includes three writing heads 31, 32, 33 which operate concurrently to print e.g. the name, street address, and place name, note col. 3, lines 57-68.

The Examiner has held that it would have been obvious to use the printing steps of Mowry with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner. To the contrary, the skilled person would surely refrain from doing so, since the Mowry printing operation, which utilizes pressure sensitive frangible capsules which contain the ink forming chemicals, is highly specialized and clearly too expensive for use on mass produced articles such as printed products being conveyed in an imbricated stream. Further, the printing produced by the Mowry process is sensitive to any applied pressure, and this fact would render it clearly unsuitable for use in an imbricated stream of printed products, which are inherently subject to relative movement and rough handling. Thus there not only is no teaching, suggestion, or incentive to support the proposed combination of Mowry and Fröhlich, but in reality, there would be significant incentive not to make the combination.

Claims 8-10 are Separately Patentable

Claims 8-10 define the method of the invention with more particularity by reciting that the partially transparent contrast panel is printed onto the border region of each product of the imbricated stream, so as to overlie the printing on the printed surface of each product and so as to allow the underlying printing to be seen through the contrast panel. These claims thus highlight an important feature of the present invention, namely, that both the underlying printed text and the printing on the label can be seen and read. Nothing in the cited prior art teaches or suggests this specific feature of the present invention.

Claim 11 is Separately Patentable

As noted above, Fröhlich discloses the use of an ink jet writer 34' to print an address on the exposed margin of a series of newspapers as they are moved into an imbricated stream, and the writer 34' includes three writing heads 31, 32, 33 which operate concurrently to print e.g. the name, street address, and place name, note col. 3, lines 57-68. Thus neither of the cited documents discloses "printing means...for printing a partially transparent contrast panel...and for forming information within or on each contrast panel", as recited in base Claim 11. In other words, base apparatus Claim 11 defines the printing means as printing two superposed elements, namely, the contrast panel and the information, and the cited references fail to teach or suggest this concept.

(b) Claims 6, 9, and 12 were rejected as being unpatentable over Mowry and Fröhlich as applied above, and further in view of Gurwick. Gurwick was applied in view of its teaching of printing information onto a panel, but the

patent fails to supply the deficiencies of the combination of Mowry and Fröhlich as set forth above. More particularly, Gurwick discloses a transparent printed wrapper, especially made of cellophane. At the time of its filing, i.e. in the early 1930's, it seems to have been difficult or costly to produce tinted cellophane papers. Gurwick therefore suggests coating an already manufactured blank transparent cellulose paper with a layer or coating of transparent ink (page 2, left col., lines 11-15). Gurwick further suggests printing different colors side by side (leaving areas for the respective other colors free) rather than onto each other (page 2, right col., lines 70ff). However, Gurwick does not disclose or suggest starting with a printed product and printing a contrast panel, as defined, onto the product. In particular, Gurwick does not disclose or suggest using a partially transparent contrast panel, such that the panel can be placed upon the printing of the product and so that the underlying printing can be seen. Nor does Gurwick disclose or suggest the "printing" and "forming information" steps which involve separate printing operations which are superposed, i.e. the information is printed within or on the contrast panel, as claimed.

(c) The prior patent to Reist was applied to reject dependent Claim 14, which specifically defines the conveyor system as comprising a plurality of clamps. Such a conveyor system is *per se* well known in the art, but Reist also fails to supply the above noted deficiencies of Mowry and Fröhlich.

(d) Claims 5-13 were also rejected as being unpatentable over "A Century of Comics" (as discussed in the article entitled "1933: The First Comic Book") in view of Fröhlich. Also, in connection with this rejection, the Examiner has

referred to the article "Understanding Color" for a description of four color printing.

The "1933: The First Comic Book" article refers to the four color printing process and shows several cover pages of comic books with a title and some illustrations. The title is either printed in black on a uniform (presumably colored) background (see "Funnies on Parade" shown on the first page of the article) or it is printed in white on a black or gray background (see "Century of Comics" on the third page of the article).

The Examiner has attempted to equate the printed portions of the referenced comic books with the claimed partially transparent contrast panel and with the claimed printing step. Specifically, the Examiner has taken the position (as best it can be understood) that the second layer of four color printing permits the original layer of printing to be seen therethrough, and thus the second layer constitutes the claimed partially transparent contrast panel which is applied to a printed surface and that this layer, or a subsequent layer, is printed so as to apply text on the contrast panel.

The Examiner's application of the described comic books to the claimed invention is untenable for the reason that in four color printing, the underlying layer cannot be "seen through" later applied layers. Rather, the printed layers combine to absorb selected wavelengths while reflecting other wavelengths, so as to result in the color we see. This is made clear in the cited Understanding Color article. Thus there is no basis to contend that the "A Century of Comics" publication teaches the use of a partially transparent contrast panel as that term is defined in the present application.

In response to the applicant's argument that four color printing does not allow for the underlying layer to be "seen through" later applied layers, the Examiner stated in the Answer of November 16, 2004 that such would be the case when using a "transparent" ink. The Examiner has not demonstrated that a transparent ink would ever be used in a four color printing operation, but rather, she has contended that the claims do not recite that the "text on a lower layer must be different in format or content from the additional layers". The claims at issue do in fact define very specifically the partially transparent contrast panel, note for example, the paragraph beginning at page 3, line 32 of the specification, which clearly would distinguish the contrast panel from the underlying layer or printing.

Nor is there any basis to contend that the four color printing process could be employed to apply text to printed products being conveyed in an imbricated stream. In this regard, the present invention starts where "A Century of Comics" ends. The present invention teaches that a completed printed product (e.g. a comic book as shown in "A Century of Comics", printed by whatever method) is furnished with a contrast panel applied to the border region of the already finished product, while conveying it in an imbricated formation. Applying a contrast panel in this way is not at all possible while making the "Comics" cover page itself. A four color printing is usually done using a rotary printing press, which requires feeding of single sheets of paper, and such a press would not be able to print on products which are conveyed in an imbricated stream. Therefore, there would have been no motivation at all to combine "A Century of Comics" with Fröhlich, and in fact this would appear to be technically difficult if not impossible.

Claims 8-10 are Separately Patentable

The "Century of Comics" article and Fröhlich, even when considered collectively, do not disclose or suggest printing the contrast panel on a border region of the printed product which has a printing thereon, so as to overlies at least a portion of the printing on the border region, as further recited in Claim 8 and dependent Claims 9 and 10.

Claim 11 is Separately Patentable

An apparatus having the features of Claim 11 is neither disclosed nor rendered obvious by the "Century of Comics" article and Fröhlich for the same reasons as already discussed.

As noted above, apparatus Claim 11 defines the printing means as comprising printing the contrast panel and forming information within or on the contrast panel. Fröhlich does not teach or suggest this concept.

Claims 6, 9, and 12 are Separately Patentable

Claims 6, 9, and 12 define the "printing" and "forming information" operations as being separate and superposed, as discussed above. The "Century of Comics" and Fröhlich references neither teach or suggest this feature, even when considered collectively.

(e) Claim 14 was rejected based upon a proposed combination of "A Century of Comics" in view of Fröhlich, and further in view of Reist.

Claim 14 is specific to the embodiment wherein the recited conveyor system comprises a plurality of clamps, and the prior patent to Reist was cited for its disclosure of such a conveyor. However, Reist does not supply the deficiencies

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of the proposed combination of "A Century of Comics" and Fröhlich as set forth above, and Claim 14 is accordingly seen to be allowable along with base Claim 11.

**CONCLUSION**

For the reasons set forth above, it is respectfully submitted that the Examiner's rejections of Claims 5-14 are legally untenable, and should be reversed. Such action is solicited.

Respectfully submitted,

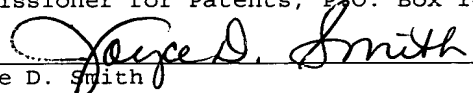


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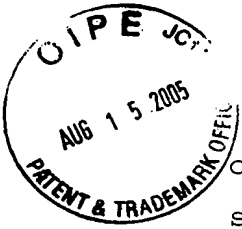
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\_\_\_\_\_  
Joyce D. Smith

CLAIMS APPENDIX



5. A method of providing text on a printed surface of each of a plurality of printed products comprising the steps of

conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap, while

printing a partially transparent contrast panel onto the exposed border region of each printed product, and while

forming information within or on each contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read.

6. The method as defined in Claim 5 wherein the printing step comprises printing the contrast panel onto the printed surface of each printed product as it passes a first printing station along the path of travel, and the forming information step comprises printing the information onto the contrast panel of each printed product as it passes a second printing station along the path of travel.

7. The method as defined in Claim 5 wherein the forming information step includes forming blank areas within the contrast panel, with the blank areas forming the information.

8. A method of providing text on each of a plurality of printed products having printing thereon, comprising the steps of



conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product which has printing thereon is exposed by the imbricated overlap, while

printing a partially transparent contrast panel onto the border region of each printed product so as to overlie at least a portion of the printing on the border region, and so as to allow the printing on the border region to be seen therethrough, and while

forming information within or on each printed contrast panel which forms a contrast with respect to the contrast panel so that the information can be easily seen and read.

9. The method as defined in Claim 8 wherein the forming information step comprises printing the information onto the contrast panel.

10. The method as defined in Claim 8 wherein the forming information step comprises forming blank areas within the contrast panel during the printing step.

11. An apparatus for providing text on a printed surface of each of a plurality of printed products comprising

a conveyor system for conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap,

printing means disposed along the path of travel for printing a partially transparent contrast panel onto the exposed border region of each printed product so as to allow the printed surface of the printed product to be seen therethrough and for forming information within or

on each contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read.

12. The apparatus as defined in Claim 11 wherein the printing means comprises a first printing station disposed along the path of travel for printing the contrast panel, and a second printing station disposed along the path of travel downstream of the first printing station for printing the information onto the contrast panel.

13. The apparatus as defined in Claim 11 wherein the printing means comprises a printing station disposed along the path of travel which acts to print each contrast panel with blank areas, with the blank areas forming the information.

14. The apparatus as defined in Claim 11 wherein the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

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RELATED PROCEEDINGS APPENDIX

Attached to this Appendix is:

- Decision on Appeal No. 2002-2125, dated May 23, 2003.

#4735597v1

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

MAY 23 2003

*Ex parte* MARKUS SCHEUBER  
and  
HANS FREI

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2002-2125  
Application No. 09/078,914

ON BRIEF

Before KRATZ, DELMENDO and MOORE, *Administrative Patent Judges*.

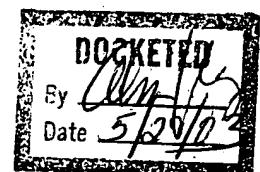
MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 5, 6, 7, 8, 11, 19, 20, 21, 22 and 23. Claims 1-4, 9-10 and 12-18 have been canceled. Thus, claims 5-8, 11, and 19-23 are before us on appeal.

REPRESENTATIVE CLAIM

The appellants have indicated that claims 5-8 stand together; claims 11, 20 and 21 stand together; claims 22-23 stand together, and claim 19 stands alone. Accordingly, we shall focus our attention on claim 8 (the independent method claim), claim 11 (the



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broadest dependent method claim), claim 22 (the broadest apparatus claim) and claim 19, which stands alone. Note In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998); In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

These claims read as follow:

8. A method of providing text on a printed surface of each of a plurality of printed products having printing thereon comprising the steps of

conveying the printed products along a path of travel in an overlapping imbricated stream and such that a border region of the printed surface of each printed product is exposed by the imbricated overlap, while

applying a partially transparent contrast panel to the exposed border region of each printed product with the contrast panel overlying the printing on the printed surface and allowing the printing on the printed surface to be seen therethrough, and

forming information within or on each contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read.

11. The method as defined in Claim 8 wherein the applying step includes adhesively bonding a label to the printed surface of each printed product, and the forming information step includes printing the information onto each label after it is adhesively bonded to the printed surface.

19. The apparatus as defined in claim 22 wherein the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

22. An apparatus for providing text on a printed surface having printing thereon of each of a plurality of printed products comprising

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a conveyor system for conveying the printed products along a path of travel in an overlapping imbricated stream and such that a border region of the printed surface of each printed product is exposed by the imbricated overlap,

label applying means disposed along the path of travel for applying a partially transparent contrast label to the exposed border region of each printed product so as to overlies the printing on the printed surface of the printed product and to allow the printing to be seen therethrough, said label applying means comprising means mounting a supply roll of a strip of partially transparent label forming material, a cutting system for withdrawing the strip from the supply roll and cutting the same into individual labels, and an application device for sequentially applying the individual labels onto the printed products, and

printing means for printing information onto each label.

#### The References

In rejecting the claims under 35 U.S.C. § 103(a), the examiner relies upon the following references:

Doane et al. (Doane)	2,715,975	Aug. 23, 1955
Jackson	4,149,711	Apr. 17, 1979
Popat et al. (Popat)	5,407,718	Apr. 18, 1995

#### The Rejections

Claims 5-8, 11, and 19-23 stand rejected under 35 U.S.C. § 103(a) as obvious over Doane in view of Jackson and Popat.

#### The Invention

The invention relates to a method and apparatus for applying printed text. Multiple printed products are conveyed in an overlapping ("imbricated") stream, which provides for an exposed border region in each of the products. A partially transparent label is applied over the printed product, and the underlying

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printing can be seen while the printing on the label can be read.. (Appeal Brief, page 2, lines 4-11). Further details of the claimed invention are seen by reference to claims 8, 11, 19, and 22 reproduced above.

#### Discussion

#### The Rejection of Claims 5-8, 11, and 19-23 under 35 U.S.C. §103(a)

Claims 5-8, 11, and 19-23 stand rejected under 35 U.S.C. § 103(a) as obvious over Doane in view of Jackson and Popat. The Examiner has found that Doane teaches a method and apparatus for address labeling articles fed in partial or overlapping relationship using a feed conveyor having individual lugs to engage and move each article past a label applying head. The label applying head includes a supply reel, a knife, a paste applying roller, and a label applying roller. (Examiner's Answer, page 3, line 18 - page 4, line 5).

The examiner has further found that Jackson teaches a printing system for printing personalized information onto an adhered label on a magazine moving along a conveyor. (Examiner's Answer, page 4, lines 7-10).

The examiner has additionally found that Popat teaches that a stark white address label creates a cheap, mass-produced appearance. Labels may be made from transparent paper label sheets to provide clear labels. A paper label should have a

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contrast ratio of 30-40% and be slightly tinted for decorative effect. (Examiner's Answer, page 4, lines 11-17).

The examiner then concludes that it would have been obvious to have modified the apparatus of Doane by providing a printing system as taught by Jackson to print personalized information on the magazines. The examiner further concludes it would have been obvious to use the partially transparent labels of Popat to obviate the cheap, mass-produced white labels. (Examiner's Answer, page 4, line 18 - page 5, line 11).

The appellants initially argue that there is no motivation to make what they characterize as a "highly selective" combination of the various features of the three applied references (Appeal Brief, page 3, lines 26-30).

The appellants challenge the stated content of the principal reference, Doane, stating that it does not disclose that the border region has a printed surface or that the label is transparent. (Appeal brief, page 4, lines 8-13). We disagree with the appellants' interpretation of Doane.

First, Doane clearly describes that the label is to be applied to a magazine, newspaper, catalogue, flyer, or tabloid (Column 1, lines 16-17) which may have a three or four color ink work on its cover (column 1, lines 43-44), where the label is to be applied. Second, Doane is not relied upon for the disclosure



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of a transparent label. Popat discloses a partially transparent label.

The appellants then state that the Jackson reference is "non-analogous" in that it teaches the separate handling of products and one concerned with imbricated streams would not look to Jackson. We disagree with this interpretation of Jackson. Imbricated streams and individual processing are not so different that one of ordinary skill in the art would not look to Jackson. Indeed, we find that Figure 3 of Jackson illustrates an imbricated stream (Reference Numerals 107, 18) feeding the labeling and printing station. While in this embodiment the actual printing does not occur on the imbricated stream, the appellants' argument that imbrication and Jackson's printing method are unrelated clearly fails.

The appellants finally assert that the use of Popat, which is said to relate to a particular construction of clear labels which are removed by a user and applied to envelopes, is improper (Appeal Brief, page 4, lines 24-36). Consequently, it is urged, no modification of an imbricated stream can be suggested. The appellants' argument is misplaced. Popat is not suggesting that the imbricated stream be altered, but is relied upon by the examiner for the proposition that cheap white labels be replaced with transparent or tinted labels. We therefore find this

argument unpersuasive and conclude that the examiner has properly combined the instant three references.

The appellants next argue that, even when the references are considered collectively, they do not disclose the instantly claimed invention. They urge that none of the references disclose the feature that the label is applied to the exposed region of the products of an imbricated stream so as to overlie the printing thereon, and that the references do not teach a partially transparent contrast panel. (Appeal Brief, page 5, lines 4-11).

As regards the first portion of this argument, it is clear that Doane discloses that the cover may be printed as discussed above. As regards the second portion of this argument, it is urged that Popat only discloses clear labels and that "[t]here is no hint that the label might be anything else but clear or substantially transparent." (Appeal Brief, page 5, lines 32-33). Such clear labels are stated to be invisible when applied, and therefore, it is asserted, they cannot be a contrast panel. (Appeal Brief, page 6, lines 12-18).

This viewpoint overlooks the clear teaching in Popat that the decorative labels need not be entirely transparent. (Column 5, lines 43-45). While it is true that one part of this cited teaching is made by way of decorative tinting, the appellants also overlook the importance of the teaching at column 3, line 53 -

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column 4, line 17 regarding the transparency of the paper used for printing the labels. Taken together, they teach one of skill in the art that the labels need not be perfectly transparent.

Further, the claimed subject matter recites only a "partially transparent contrast panel." The specification, page 3, lines 7-13 provides that:

A contrast panel, which forms a text panel, is applied to the exposed border region of each printed product, and the contrast panel forms a contrast with respect to the information which is to be applied. This ensures that the information always appears in contrast with respect to its surroundings and thus can be seen and read easily.

The appellants urge, and have provided two examples which they assert support this point of view, that the panel itself constitutes a contrast to the underlying cover printing and helps to direct the user's look to the panel. (Appeal Brief, page 8, lines 2-16; see also unnumbered document dated October 31, 2001 entitled "Submittal of Exhibits Under 37 CFR 1.195.")

It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992). See also In re Azorlosa, 44 CCPA 826, 241 F.2d 939, 941, 113 USPQ 156, 158 (1957), which holds, in pertinent part, that it is proper for the court and necessarily, the board, to consider everything that a reference discloses.

Popat discloses a particular embodiment where a blue envelope is provided with a transparent paper label having a slightly reddish tint. When used on a blue envelope, it is observed that the area underneath the label has a slightly purple tint. (See Popat, column 5, lines 45-48). We find that this change in the tint will draw the eye to the label without obscuring the area under the label, within the meaning of the appellants' specification and claims.

We therefore agree with the examiner's interpretation of Popat that it is not limited to a "substantially" transparent label. We furthermore conclude that a prima facie case of obviousness has been established, for the reasons expressed by the examiner, and those recited above.

Turning now to the dependent claims, the appellants observe that dependent claims 11, 20, and 21 require a label to be adhesively applied to the printed surface of each printed product in the imbricated stream, and that the information is printed onto each label after the label is adhesively bonded to the printed surface. (Appeal Brief, page 9, lines 15-20). The appellants assert that Jackson's teaching of separately handled products is non-analogous to the instantly claimed imbricated stream, the proposed addition of a printing step to Jackson's conveyor would not be obvious because there is no room downstream where the

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products are in synchronization, and a total redesign of Doane would be required to print after the labels are applied. (Appeal Brief, page 9, lines 23-35).

We note that, in justifying the combination of reference teachings in support of a rejection, it is not necessary to show that a composition or device described in one reference can be physically inserted into the composition or device described in the other. Cf. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference ..... Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.").

As above, we note that imbricated or individual transfer are closely related, as evidenced by Jackson's feeder stream of imbricated articles. Again, we are not persuaded by this argument.

We agree that Doane's disclosure does not disclose a printer after the labels are applied. However, we are not persuaded by the unsupported conclusion that Jackson's printer could not be included without a total redesign of Doane. There is no evidence of record that a printing head could not be incorporated into Doane, merely attorney argument, which is not evidence. It is

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the combination of Doane and Jackson and Popat which render the instantly claimed invention obvious. Additionally, we have not observed a requirement in Doane that the labels must always be pre-printed. Finally, the Jackson printer discloses motivation for its addition - the inclusion of on-line printing of personalized information. (Abstract, lines 4-6). We therefore are not persuaded by these arguments relating to dependent claims 11, 20, and 21.

The appellants have also argued claim 19 separately, in that it discloses a conveyor system including a plurality of clamps for gripping respective ones of the printed products, which is said not to be suggested by the cited references. (Appeal Brief, page 10, lines 1-6).

The examiner has stated that providing lugs or clamps for engaging each article would have been obvious to one of ordinary skill in the art to provide means to ensure feeding of the articles in overlapping relationship. (Examiner's Answer, page 5, lines 18-20).

Although we find that retention of placement on a conveyor is well known, as evidenced by the lugs in Doane (column 2, line 32) we cannot say that the claimed clamps are rendered obvious by the lugs without evidence in the record to support this conclusion. We therefore reverse this rejection as it applies to claim 19.

The appellants also argue that claims 22 and 23 are separately patentable as defining the use of printing means or station positioned to print the individual labels. It is asserted that Doane utilizes pre-printed labels and there is no suggestion to incorporate a printing station in Doane. Finally, it is again contended that a major redesign of Doane would have to be accomplished to include a printing station. (Appeal Brief, page 10, lines 7-17).

As noted above, Doane teaches only the application of a perforated address label (column 3, lines 68-69). It is not expressly required that it be a preprinted label. Further, we again note that there is no evidence whatsoever that the addition of a printing head would require a major redesign of Doane such that Doane can be read as teaching away from its inclusion. Finally, we note again that the three references in combination render the instantly claimed invention obvious, and the references should not be considered exclusively individually. We therefore affirm the rejection as it applies to claims 22 and 23 as well.

#### Rebuttal Evidence

The appellants have submitted, in a document dated October 31, 2001, two exhibits, which they state establish novelty and unobviousness. (Appeal Brief, page 7, paragraph c et seq.). A prima facie case of obviousness may be rebutted if the appellant

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(1) establishes unexpected properties in the claimed composition or (2) shows that the art, in any material respect, teaches away from the claimed invention. In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). Declaration evidence must be properly considered and the entire matter reweighed (see, e.g. In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 688 (Fed. Cir. 1986)). Whether evidence shows unexpected results is a question of fact and party asserting unexpected results has the burden of proving that the results are unexpected. In re Geisler, 116 F.3d 1465, 1469-70, 43 USPQ2d 1362, 1364-5 (Fed. Cir. 1997).

As regards the two examples provided by the appellants, we see the difference emphasized by the appellants - the partially transparent, almost translucent quality of the claimed label and the printing thereon, versus the clear label.

However, we are unpersuaded that the contrast panels presented are representative of the claimed process or the appropriate prior art. First, neither example is prepared according to the claimed process. The labels appear to be taped on after they were printed, and the location of the labels in exhibit B cannot be said to be in a border region. Additionally, neither example represents the closest prior art, which would incorporate the tinted example of Popat. Furthermore, we fail to see much difference at all in exhibit a.



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Finally, the exhibits are unaccompanied by a statement in the form of a declaration containing information about the provenance or properties of the examples. Accordingly, we give the exhibits little probative weight. Although a useful illustrative tool, on balance, they are insufficient to overcome the prima facie case of obviousness.

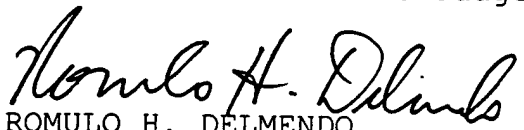
Summary of Decision


The rejection of claims 5-8, 11, and 19-23 under 35 U.S.C. § 103(a) as obvious over Doane in view of Jackson and Popat is sustained as to claims 5-8, 11, and 20-23, and reversed as to claim 19.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART**

  
PETER F. KRATZ )  
Administrative Patent Judge )

  
ROMULO H. DELMENDO ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND

  
JAMES T. MOORE ) INTERFERENCES  
Administrative Patent Judge )

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